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OFFICE OF PETITIONS

In re Application of :
Kalled et al. : DECISION ON APPLICATION
Application No. 10/576,527 : FOR PATENT TERM ADJUSTMENT
Filed: 05/01/2007 :
Docket No. 08201.0042-00000 :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT-PRE-GRANT," filed October 20, 2010, which is being treated as a petition under 37 CFR 1.705(b). Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected to one hundred fifty-one (151) days.

The application for patent term adjustment is DISMISSED.

On July 21, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 104 days. On October 20, 2010, applicants timely submitted the instant application for patent term adjustment¹. Applicants state that the application is not subject to a terminal disclaimer.

On petition, applicants assert that they are entitled to 47 days of Office delay pursuant to 37 CFR 1.702(a)(2). Specifically, applicants explain:

The PTO mailed an Office Action, which was an additional Restriction Requirement, on June 1, 2009.

¹ The Office records show that the issue fee was received on October 20, 2010.

Applicants filed a response on September 1, 2009.

The PTO mailed a Final Office Action on November 23, 2009.

On February 17, 2010, the PTO mailed a Non-Final Office Action, which stated that the Final Office Action of November 23, 2009, had been withdrawn, resulting in a PTO delay of 47 days beyond the 4 months provided by 35 U.S.C. § 154(b).

Petition, 10/20/10, p. 2.

The Office has considered applicants' argument, but does not find it persuasive. Pursuant to 37 CFR 1.702(a),

Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken;

On November 23, 2009, the examiner responded to applicants' reply to the Restriction Requirement filed on September 1, 2009. The final Office action of November 23, 2009, met the minimum requirements of an action under 35 U.S.C. 132 and was mailed within four months of the September 1, 2009 filing date of the reply. Accordingly, no period of adjustment for Office delay was entered. A review of the record confirms that no period of adjustment for Office delay is warranted.

The subsequent mailing of the non-final Office action by the examiner withdrawing the Office action of November 23, 2009, does not negate the fact that the Office took action in this application within the meaning of § 1.702(a)(2) on November 23, 2009. Specifically, the Office notes that an examiner does not have the authority to vacate or rescind an Office action. Unless vacated by the Technology Center Director, the action originally mailed by the examiner on November 23, 2009, will be used for purposes of calculating patent term adjustment.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

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